PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) SON-3031

	Application Number 10/560,358-Conf. #8888	Filed December 12, 2005
	First Named Inventor Fumio Shimizu et al.	
	Art Unit 2178	Examiner K. R. Stork

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
   Note: No more than five (5) pages may be provided.

I am the

☐ applicant /inventor.

☐ assignee of record of the entire interest.
   See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
   is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.
   Registration number   24,104/40,290

☐ attorney or agent acting under 37 CFR 1.34.
   Registration number if acting under 37 CFR 1.34.   _____

Signature

Ronald P. Kananen/Christopher M. Tobin
Typed or printed name

(202) 955-3750
Telephone number

November 6, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of ___1___ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Fumio Shimizu et al.

Application No.: 10/560,358   Confirmation No.: 8888

Filed: December 12, 2005   Art Unit: 2178

For: EDITING DEVICE AND METHOD   Examiner: K. R. Stork

REQUEST FOR PRE-APPEAL BRIEF PANEL REVIEW OF FINAL REJECTION

Dear Sir:

INTRODUCTORY COMMENTS

This communication is responsive to the Final Office Action dated June 6, 2008, in this application, and is concurrently filed with a Notice of Appeal and request for extension of time. It is anticipated that Panel Review will obviate the need for the filing a Brief. Accordingly, Applicant respectfully requests pre-appeal brief panel review of the Final Office Action, and allowance of the claims in this application.

In the Action, claims 1 and 4 have been rejected under 35 U.S.C. 102(e) and claims 7 and 8, which depend from claims 1 and 4, respectively, have been rejected under 35 U.S.C. 103(a) as detailed below.

Claims 1 and 4 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pub. No. 2003/0206203 to Ly ("Ly"). This rejection is traversed.

Ly discloses a method of collaborating with unstructured data using multiple concurrent collaboration displays. (Ly, para. [0010].) "Each collaboration display may use a selectable set of categories to display the data object." (*Id.* at [0010].) "In this way, each collaboration display may be configured to view the data object with a desired level of structure." (*Id.* at [0010].)

Ly discloses that "[b]y selecting and focusing on particular categories, each user may view the same data in a manner that is most effective for that particular user." (*Id.* at [0011].) Accordingly, multiple concurrent users may use and arrange data in a way that "keeps the structure from impeding creativity." (*Id.* at [0011].)

Ly discloses that a data arrangement may have several data objects, for instance data object 341. (*Id.* at [0085], FIG. 22.) The data objects of the data arrangement 322, 324 are stored in data arrangement files 329, 331. (Ly, para. [0085].) Different collaborating data arrangements may not display the same set of data objects. (*Id.* at [0086].) However, certain data objects may be "imported" from one data arrangement to another. (*Id.* at [0086]; *see also* data object 341 imported from data arrangement 322 into data arrangement 324 in Ly FIG. 22.) The importation is accomplished via a communication between the data arrangement files 329, 331 of the collaborating data arrangements 322, 324. (*Id.* at [0086].) Once the importation from data arrangement 322 to data arrangement 324 is complete, the imported data arrangement is shown as 341a. (*Id.* at [0086].)

Once the data object is imported, the imported data object may be either linked or unlinked to the original data object. (*Id.* at [0086].) If linked, then, if the user of a original data arrangement 322 makes changes to a original data object 341, the system may be configured to seek approval from the user of the importing data arrangement 324 before updating the change to the corresponding imported data object 341a. (*Id.* at [0086].) The corresponding data object 341a could also not be updated at all. (*Id.* at [0086].)

Similarly, if the user of the importing data arrangement user makes changes to the imported data object, the imported data object may be linked and any changes may be reflected back to the original data object in the original data arrangement. (*Id.* at [0086].) Additionally, changes to the

imported data objects could be reflected back to the original data object in the original data arrangement automatically or after an approval process. (*Id.* at [0086].)

Ly discloses that the collaboration framework allows clients to share their modifications, in near real time, with other clients. (*Id.* at [0089], lines 1-3.) When a user modifies the document, that collaborative edit is substantially immediately routed to all other interested parties via a collaboration server. (*Id.* at [0089].) Network traffic is minimized by propagating only the changes to collaborating clients, instead of the entire data set. (*Id.* at [0089].) "[C]hanges are propagated as proposed changes that are presented to users for acceptance." (*Id.* at [0089].) "Using such proposed changes allows inputs from all users to be accommodated, but reduces errors from simultaneous changes and possible inconsistent displays." (*Id.* at [0089].)

Ly, however, fails to disclose many of the features recited in claim 1. For instance, Ly suggests only editing based on user actions, disclosing that a user may interact with the data in a "freeform and creative way," using "a graphical interaction device, such as a mouse, or other pointing device to arrange, add, and delete notes to facilitate a creative thought process." (*Id.* at [0037].) Ly further discloses that the electronic process is constructed to "advantageously" use graphical interactions, "such as dragging and dropping functions, for facilitating ease of use and efficient interactions." (*Id.* at [0037].) Ly also discloses that modifications are shared with other clients, routing the edited data to other interested parties. (*Id.* at [0088] and [0089].)

But Ly makes no mention whatsoever of "*[a]n editing device for executing an editing process based on a list specifying edit details and registering an obtained editing result in an external device[.]*"

Further, Ly fails to disclose or suggest "*[a]n editing device... wherein [a] control means controls [a] processing means so as to perform the process on only necessary parts out of the edit material based on the list and controls said registration means so as to register only a result of the process of the necessary parts as the editing result in the external device when the list being created is reproduced according to external operation in a creation mode of the list.*"

3

In the Advisory Action, the Examiner disagrees stating, "[o]nce a user performs a change, the changes are routed to other clients, allowing for the change to be accepted or rejected. This propagated change constitutes at least a single item list, specifying the details of the edit." (Advisory Action, Continuation Sheet, 11.)

However, this construal of Ly clearly mistakes processing with registering only a result of the process of the necessary parts as the editing result in the external device. Nevertheless, even if it is presumed that the propagated change of Ly constitutes a "single item list," Ly does not disclose, among other things, that the editing process itself (i.e. the performed change which is propagated) was made based on a list specifying edit details as recited in claim 1.

Because Ly fails to teach, disclose, or suggest each and every limitation of claim 1, reconsideration and withdrawal of the 35 U.S.C. § 102(e) rejection of claim 1 is respectfully requested. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1566 (Fed. Cir. 1989).

For reasons similar to those provided regarding claim 1, Ly fails to teach, disclose, or suggest each and every limitation of claim 4. Accordingly, reconsideration and withdrawal of the 35 U.S.C. § 102(e) rejection of claim 4, as being anticipated by Ly, is respectfully requested.

Claims 7 and 8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pub. No. 2003/0206203 to Ly ("Ly") in view of U.S. Pub. No. 2003/0219226 to Newell et al. ("Newell"). This rejection is respectfully traversed.

Claims 7 and 8 depend from claims 1 and 4, respectively, and thus incorporate the features recited therein. For the reasons stated above, Ly fails to teach, disclose, or suggest many of the features incorporated into claims 7 and 8, and Newell does not remedy the deficiencies of Ly.

Newell discloses "a method and system for accessing video data stored on a hard disk storage device." (Newell, para. [0009].) Newell's disclosure involves a processor "used to generate a preview sequence comprising video sequences extracted from each video program in the storage device." (*Id.* at [0009].) "The preview sequence may be provided as a grid containing a plurality of

4

video sequences and other textual or graphical data related to the programs displayed, or may be provided as a sequence of video sequences." (*Id.* at [0009].) Further, Newell discloses that "[t]he processor also generates a graphical use interface to allow a user to select a video program from video sequences that are displayed." (*Id.* at [0010].) Then, "[o]nce selected, the program corresponding to the video sequence may be viewed, deleted, or edited." (*Id.* at [0010].)

The Newell reference is apparently relied upon for its disclosure wherein the sequential part registration is prompted by a selection of a preview command; however, the reference offers no disclosure or suggestion of the features described above as being absent from Ly.

Because the relied-upon references, even in combination, still fail to yield Applicant's claimed invention, a prima facie case of obviousness has not been presented regarding claims 7 or 8. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 7 and 8 under 35 U.S.C. 103(a) as being unpatentable over Ly in view of Newell.

For the various reasons noted above, Applicant submits that there are clear deficiencies with regard to the rejections of both the independent and various dependent claims. Applicant thus requests reconsideration and withdrawal of these grounds of rejection at the direction of the Panel, and further submits that this application is in condition for allowance.

The Examiner is invited to contact the undersigned representative if it is believed that such contact would further the prosecution of this application.

Dated: November 6, 2008

Respectfully submitted,

By

Ronald P. Kananen
   Registration No.: 24,104
Christopher M. Tobin
   Registration No.: 40,290
RADER, FISHMAN & GRAUER PLLC
Correspondence Customer Number: 23353
Attorneys for Applicant